

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOHN R. BRADY

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Appeal No. 98-1428  
Application No. 08/590,388<sup>1</sup>

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ON BRIEF

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Before MEISTER, FRANKFORT, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed January 25, 1996. According to appellant, this application is a continuation of Application No. 08/338,002, filed November 10, 1994, now abandoned.

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This is a decision on appeal from the examiner's final rejection of claims 1 through 13, which are all of the claims pending in this application.

Appellant's invention relates to a flexible liner for insertion into a waste receptacle and to a method of installing such a flexible liner in a waste receptacle. Independent claims 1, 10 and 12 are representative of the subject matter on appeal and a copy of those claims may be found in Appendix A of appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

|                 |           |          |
|-----------------|-----------|----------|
| Meroney<br>1964 | 3,148,799 | Sep. 15, |
| Cote<br>7, 1977 | 4,027,774 | Jun.     |
| Metcalf<br>1991 | 5,028,022 | Jul. 2,  |

An additional prior art reference of record in the present application relied upon by this panel of the Board in a new ground of rejection entered pursuant to 37 CFR § 1.196(b) is:



OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review we have reached the determinations which follow.

Looking to the examiner's prior art rejection of appealed claims 1 through 9 under 35 U.S.C. § 103 as being unpatentable over Metcalf in view of Meroney, we note that both of these patents disclose a waste receptacle liner and method of use wherein a frame structure is associated with the liner as a means for holding the liner to the top portion of the waste receptacle. In Metcalf, the frame structure is a separate member that fits over and around the outside of the liner (4) after the liner has been inserted into a trash receptacle (2) and has had a top portion thereof folded over the top edge of the receptacle, as seen, for example, in Figures 2, 7 and 8. The frame structure (e.g., Figs. 3-6) includes downwardly depending grasping fingers (14) directed toward the interior

of the trash receptacle, or, as seen in Figure 7, includes deformable scalloped projections (21) that may be deformed interiorly of the trash receptacle, so as to capture the liner relative to the trash can.

In Meroney, the frame structure (e.g., 38, 40, 42, 44 of Figure 1) is made of stiffened paper or plastic (col. 3, lines 9-12) and is attached to the interior surface of the liner sleeve (32) by adhesive or heat sealing. Figure 4 of Meroney shows a simplified version of the receptacle liner therein where only panels (68, 70) are provided at the mouth of the liner sleeve. As can be seen in Figure 5, the panels (68, 70) may carry a pressure-sensitive adhesive strip (76) protected by a readily removable protective film (78) for allowing the panels to be attached to the exterior of a receptacle to assist in holding the liner sleeve about the rim of the receptacle.

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Contrary to the examiner's reasoning on pages 3-4 of the answer, we do not consider that it would have been obvious to one of ordinary skill in the art

to have employed an adhesive strip along the bag upper edge in the device of Metcalf, in view of the adhesive mounting strip teaching in Meroney, motivated by the cost savings of employing such mounting teaching and the elimination of the need for the channel member in Fig. 1 of Metcalf.

Like appellant, we see no teaching or suggestion in either Metcalf or Meroney which would have motivated one of ordinary skill in the art to combine these references so as to result in eliminating the frame structure (10) or (18) of Metcalf and in application of an adhesive strip directly to the bag liner (4) of Metcalf, as is urged by the examiner. If anything, it would appear to us that one of ordinary skill in the art considering the collective teachings of these patents would have, at best, found it obvious to substitute the attached frame structure of Meroney for the separate frame structure of Metcalf, thus basically resulting in essentially the same structure already disclosed in Meroney. For these

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reasons, we will not sustain the examiner's rejection of  
claims 1 through 9 on appeal under  
35 U.S.C. § 103.

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With regard to the examiner's rejection of method claims 10 through 13 under 35 U.S.C. § 103 based on Metcalf and Meroney as combined above, and further in view of Cote, we share appellant's view as expressed on pages 9-11 of the brief and in the reply brief, that the examiner's proposed combination of these patents is completely unsupported by the teachings of the references themselves and is based on impermissible hindsight derived solely from appellant's own teachings and disclosure. For that reason, the examiner's rejection of claims 10 through 13 under 35 U.S.C. § 103 will likewise not be sustained.

As is apparent from the foregoing, the decision of the examiner rejecting claims 1 through 13 of the present application is reversed.

Pursuant to our authority under 37 CFR § 1.196(b), we enter the following new ground of rejection against appellant's claims 1, 2 and 5 through 9 on appeal.

Claims 1, 2 and 5 through 9 are rejected under 35 U.S.C.



§ 103 as being unpatentable over Metcalf in view of Jaeger. Metcalf shows (in Figure 1) a flexible liner (4) for insertion into a waste receptacle (2). This liner has a construction like that set forth in appellant's claims 1, 2, 5 and 6 on appeal, except that it has no adhesive strip disposed on the outer surface of the liner side wall adjacent the upper edge thereof as required in the claims on appeal. Jaeger shows a container (10) in the form of a bag for collecting and disposing of cigarette butts, ashes and other tobacco smoking wastes. The bag includes a strip of self-sticking adhesive (36) applied to the outside of at least one side wall and a removable strip of protective cover material (38) over the adhesive. As indicated in column 2, lines 56-63, of Jaeger

The container provided with this adhesive stripe can be adhered to the edge of a table, for example, so that its opening is facing upward. In like manner, the disposable ash container can be attached, for example, to the dashboard of motor vehicles within reach of a passenger, and can thus serve in lieu of the car ash tray to receive cigarette butts and other tobacco smoking wastes.

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Further, in Jaeger column 4, lines 27-30, it is noted that the adhesive strip should be applied to the sidewall of the bag that will confront the side that is folded down when the bag is closed for disposal.

Given the collective teachings of Metcalf and Jaeger, it is our opinion that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to provide the liner bag (4) of Metcalf with an adhesive strip positioned as in Jaeger so as to allow the liner bag of Metcalf to be used in the general manner suggested in Jaeger, i.e., by being adhered to the edge of a table by the adhesive strip (36), or to a surface of the dashboard of a motor vehicle, and used for the collection of waste material, and then closed and disposed of by having an upper portion of the bag folded down and brought into contact with the adhesive strip so as to seal the bag prior to disposal.

As for the release paper of claim 7 on appeal, Jaeger provides a teaching of such a release covering at (38) to

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protect the adhesive and maintain its viability. While it is not entirely clear exactly what the specific nature of the contact adhesive strip (36) in Jaeger is, we are of the opinion that it would have been obvious to one of ordinary skill in the art that such a strip would be either a segment of two sided tape like that set forth in appellant's claim 8, or a strip of adhesive applied directly to the outer surface of the bag as in appellant's claim 9, given that both of these forms of contact adhesive strips are old and well known in the art as alternatives to one another. In this regard, we also note that Jaeger use both the term "stripe of contact adhesive" (col. 4, lines 17-18) and "contact adhesive strip" (col. 4, lines 22) to describe element (36) seen in Figure 1 of the patent.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

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§ 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136 (a).

REVERSED; 37 CFR § 1.196(b)

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| JAMES M. MEISTER            | ) |                 |
| Administrative Patent Judge | ) |                 |
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|                             | ) | BOARD OF PATENT |
| CHARLES E. FRANKFORT        | ) | APPEALS         |
| Administrative Patent Judge | ) | AND             |
|                             | ) | INTERFERENCES   |
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| JEFFREY V. NASE             | ) |                 |
| Administrative Patent Judge | ) |                 |

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REVERSED

Prepared: March 20, 2000